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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/763,362

04/23/2001

Kazuma Tomizuka

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4670

7590

05/17/2005

EXAMINER

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ART UNIT

PAPER NUMBER

1632

DATE MAILED: 05/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

09/763,362

Applicant(s)

TOMIZUKA ET AL.

Examiner

Thaian N. Ton

Art Unit

1632

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 29 April 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

a) ☒ The period for reply expires 2 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because

(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);

(b) ☐ They raise the issue of new matter (see NOTE below);

(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.

6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 93-143.

Claim(s) withdrawn from consideration: 26-83 and 85.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).


10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_

13. ☐ Other: \_\_\_\_\_.

  
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Continuation of 3. NOTE: Applicants have cancelled claim 113, certain claims depend upon cancelled claims (see claims 135 and 136). Because of the proposed claim amendments to claim 93, the deposit would be required for these claims, as well as claims dependent upon the proposed amendments (claim 138).

Continuation of 11. does NOT place the application in condition for allowance because: Applicants argue that claim 93 is amended to state the depository accession number and state that they submit a copy of the clone information with their Response. No copy of this clone information appears with the Response. Moreover, there is no appropriate statement from the Attorney of Record. See also, Final Office action, mailed 12/15/04, with regard to the deposit requirements (with regard to deposit under Budapest Treaty or deposit not made under Budapest Treaty).

The prior rejections of record, are maintained, for reasons of record advanced in the Final Office action (12/15/04).

The prior rejection, under 112, 1<sup>st</sup> paragraph, for written description and enablement, is maintained for reasons of record. Particularly, because the deposit requirements have not been perfected, the rejection is maintained.

Applicants argue that the chromosome fragments from chromosomes 2 and 22 need not be deposited because they are not generated spontaneously, but fragmented according to a repeatable and predictable telomere-truncation method. Applicants point to the specification (examples 82 and 84) and Kuroiwa (Exhibit A) for support that these fragments are not made spontaneously. The specification and Kuroiwa have been considered but are not persuasive. Although Kuroiwa teach telomere truncation, the first step in the generation of the chromosome fragments is utilizing MMCT. As established by the art and the specification, MMCT is a method that causes spontaneous fragmentation of chromosomes. For example, Kuroiwa teaches that they first transferred human chromosomes 2 and 22 into DT40 cells from mouse A9 cells by MMCT and then they used telomere truncation of the resulting fragments. See p. 3447, col. 1, last ¶. Thus, to initially generate the chromosome fragments, one must employ methods of spontaneous fragmentation of the chromosomes. As stated in the prior Office actions, these methods are not found to be reproducible nor predictable. Accordingly, it is maintained that the corresponding fragments (SC20, W23 and the 6-1 clone) must be deposited.

The prior rejection of claims 93-143 are maintained for reasons of record, and because the amendment has not been entered.

The rejection of claim 93 under 102 (Tomizuka) is maintained for reasons of record, because the amendment has not been entered.